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08/203,672	02/28/94	SILVER	B 5297/32

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EXAMINER	
TRINH, H	
ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 09/24/98

**Please find below a communication from the EXAMINER in charge of this application.**

Commissioner of Patents

<b>Office Action Summary</b>	Application No. <b>08/203,672</b>	Applicant(s) <b>Silver et al.</b>
	Examiner <b>VIKKI TRINH</b>	Group Art Unit <b>3731</b>

Responsive to communication(s) filed on Apr 22, 1996

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 4, 6, and 8-19 is/are pending in the application.

Of the above, claim(s) 4 and 15-18 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 6, 8-14, and 19 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Arguments***

1. In view of the Appeal Brief filed on April 22, 1996, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. See, for example, Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

3. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Grindrod et al. (3,740,237).

In figures 1,4, Grindrod et al. (3,740,237) disclose a bag having a front side 11, 15', 16' 17', a back side 12, 15, 16 ,17, and being initially hermetically sealed (as shown with reference number 22) about a content portion, wherein the bag includes an opening which is initially closed by a releasable seam means 20 between the front side and the back side so that the opening can be

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opened for admitting contents into the bag by pulling the front side and the back side apart along the seam means 20, as broadly interpreted of claim 6.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The courts have concluded that there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Also, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545

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(CCPA 1969). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 19880; *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

6. Claims 8-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanase (4,600,104) as being evidence of obviousness.

In figure 12, Yanase (4,600,104) discloses a bag 70 having thermoplastic film front and back sheets which are joined together by a first seal 79,78,77 being permanent sealed, and a pour spout 83 formed integral with the bag by the first seal. However, Yanase fails to show a writing area being isolated from a content portion and further being located at a bottom of the bag, wherein the pour spout is being contiguous with an inboard side of the writing area.

In figure 2, Graham (3,905,477) teaches a bag 13 having a writing area 23 formed integral with the bag by joining front 15 and back 27 sheets inboard of the bag perimeter and being isolated from a content portion and further being located at a bottom of the bag 13.

Yanase and Graham are analogous art, because they both teach bags for storing or containing intended contents.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Graham, to modify a bottom portion of Yanase's invention to include a writing area being integrally extended from the first seal 77 and being isolated from the content portion and further being contiguous with an inboard of the pour spout for easily identifying the contents in the bag.

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Regarding to claim 9, Yanase shows a notch 82 formed at the periphery of the bag and adjacent to the pour spout to tear the bag.

With respect to claim 10, Yanase shows a second seal (unlabeled), wherein the second seal is releasable and defining an opening in the content portion, and wherein the second seal is being peeled open, as described in column 8, lines 30-40.

With respect to claims 12-13, the above-mentioned elements meet the claimed limitations.

7. Claims 8, 10, 11, 12, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanase (4,600,104) as being evidence of obviousness.

Yanase in view of Graham teaches the invention substantially as claimed in claims 8 and 10, 12. However, Yanase in view of Graham does not show a tie with at least two holes.

In figure 6, Korn (3,716,182) teaches a bag having a tie and at least two holes 17.

Yanase, Graham, and Korn are analogous art, because they are in the same field of content bags.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Korn, to modify a top portion of the bag of Yanase in view of Graham to include a tie and at least two holes for conveniently closing the opening of the bag at the top portion after releasing the contents into the bag, as claimed in claims 11, 14, and 19.

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***Conclusion***

8. This Office Action is **NON-FINAL**. The Examiner withdraws the finality of the prior Office action dated 05/18/95.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikki Trinh whose telephone number is (703) 308-8238. The examiner can normally be reached Mon-Thurs, 7:30AM - 6:00 PM Eastern Time.

If attempts to reached the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Buiz, can be reached at (703) 308-0871.

General inquiries relating to the status of this application should be directed to the Group receptionist at (703) 308-0858. The fax number is (703) 308-2708.



Vikki Trinh,

Patent Examiner



MICHAEL BUIZ  
SUPERVISORY PATENT EXAMINER  
GROUP 3300

9/17/98

September 17, 1998